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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,718	10/22/2003	Shinji Shiraga	00862.023290	3954
5514 7590 05/18/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER TAYLOR, NICHOLAS R	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/689,718	Applicant(s) SHIRAGA, SHINJI	
	Examiner Nicholas R. Taylor	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 have been examined and are rejected.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 14, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claims 6 and 14 duplicate the limitations of respective parent claims 1 and 9. Claim 21 duplicates the limitations of claim 1. The Examiner also notes that were claim 19 amended to be statutorily embodied in a computer readable medium (see U.S.C. §101 discussion below), it would duplicate the limitations in claim 20.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 3, 5, and 19 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

As to claims 1, 3, and 5, the claimed language would reasonably be interpreted by one of ordinary skill in the art as a system of "software per se" and thus failing to fall within a statutory category of invention. Applicant's disclosure contains no explicit and deliberate definition for the term "means." In the context of the disclosure and claims in question, one of ordinary skill would reasonably interpret the "means" as a software application. As such, the system of "means" alone is not a machine, and it is clearly not

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a process, manufacture, or composition of matter. Thus, the claimed limitations are not limited to statutory subject matter and are therefore nonstatutory.

Claim 19 is rejected as "software per se" not embodied in a computer readable medium and is thus directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

39(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 6-10, 12, and 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ehara et al. (U.S. PGPub 2002/0069237).

10. As per claims 1, 9, 17, 19, 20, and 21, Ehara teaches a file transfer method for transferring a file recorded on a recording medium via a network to a predetermined server, said method comprising:

a step of reading, from said recording medium, said file and the positional information of a transfer destination of said file recorded on said recording medium; and (Ehara, recordable medium of paragraph 0054-0058 and fig. 2, that contains positional information in paragraph 0063)

a step of controlling to transfer said read file to a specific region on a server specified by the read positional information (Ehara, process of paragraphs 0061-0063 and the corresponding flowchart of fig. 3).

11. As per claims 2, 10, and 18, Ehara teaches the system further wherein said positional information recorded on said recording medium is inhibited from rewriting (Ehara, recordable medium of paragraph 0054-0058 and fig. 2, which contains non rewritable media).

12. As per claim 12, Ehara teaches the system further wherein all the files recorded on said recording medium are transferred to said server (Ehara, paragraphs 0060-0063).

13. As per claims 6 and 14, Ehara teaches the system further wherein said positional information indicates a specific region on any one of said plurality of servers storing the file (Ehara, paragraphs 0062, 0069, and 0070).

14. As per claims 7 and 15, Ehara teaches the system further wherein said positional information recorded on said recording medium is different for each recording medium (Ehara, paragraph 0063 where the positional information is predetermined and specific to the drive).

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15. As per claims 8 and 16, Ehara teaches the system further wherein said positional information is recorded on said recording medium before the shipment of said memory card or selling it to the customer (Ehara, paragraph 0063 where the positional information is predetermined and specific to the drive).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 3-5, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehara et al. (U.S. PGPub 2002/0069237) and Safai (U.S. Patent 6,715,003).

18. As per claims 3 and 11, Ehara teaches the above yet fails to explicitly teach the system further comprising a deletion step of deleting a file from the recording medium if the file is correctly transferred from said recording medium to said server.

Safai teaches a method of image uploading from a removable medium device (Safai, col. 5, lines 8-42; fig. 6) to a remote destination address (Safai, col. 8, lines 18-34; fig. 8), where the user selects a file to be transferred from among the recorded files (Safai, col. 11, line 44 to col. 12, line 53 and fig. 3A) and may delete correctly transferred files (Safai, col. 14, lines 33-58 and fig. 5, item 472).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ehara and Safai to provide the image transport enhancement features of Safai in the system of Ehara, because doing so would free the user from complex operations necessary to upload specific files onto a destination server (Ehara, paragraph 0036).

19. As per claim 4, Ehara-Safai teaches the system further wherein all the files recorded on said recording medium are transferred to said server (Ehara, paragraphs 0060-0063).

20. As per claims 5 and 13, Ehara teaches the above yet fails to explicitly teach the system further comprising a selection step of enabling the user to select a file transferred at said file transfer step from among the files recorded on said recording medium.

Safai teaches a method of image uploading from a removable medium device (Safai, col. 5, lines 8-42; fig. 6) to a remote destination address (Safai, col. 8, lines 18-34; fig. 8), where the user selects a file to be transferred from among the recorded files (Safai, col. 11, line 44 to col. 12, line 53 and fig. 3A) and may delete correctly transferred files (Safai, col. 14, lines 33-58 and fig. 5, item 472).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ehara and Safai to provide the image transport enhancement features of Safai in the system of Ehara, because doing so would free the

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user from complex operations necessary to upload specific files onto a destination server (Ehara, paragraph 0036).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes:

U.S. Patent No. 5,806,005, which describes a method of uploading digital images;

U.S. PGPub 2007/0061857, which describes a method of creating an image capture guide with automated uploading; and

U.S. PGPub 2003/0065773, which describes a method to automatically upload to a network server from a removable storage medium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nicholas Taylor
Examiner
Art Unit 2141



RUPAL DHARIA
SUPERVISORY PATENT EXAMINER